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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/800,030

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Jens Staack

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EXAMINER

GONZALEZ, AMANCIO

ART UNIT

PAPER NUMBER

2617

MAIL DATE

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11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/800,030 | Applicant(s) STAACK, JENS | |
| | Examiner AMANCIO GONZALEZ | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/26/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-31, 33-40, 42 and 53-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-31, 33-40, 42 and 53-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/26/2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 63 and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description requirement**. **The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.** Specifically, the limitations "computer program" and "computer readable medium" lack antecedent basis in the specification as originally filed and hence constitute new matter.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 63 and 64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims disclose a “computer program” and a “computer readable medium,” which lack antecedent basis in the specification as originally filed.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 26-29, 33-36, 40, 42, 56, 57, 59, 60, and 62-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (US 20040203770 A1), hereafter “Chen.”

Consider claim 26.

Chen discloses receiving in a mobile terminal belonging to a communication group in a mobile communication system, a triggering message indicating the communication group and informing the mobile terminal of a packet-based service session of the communication group to be initiated (*informing* reads on *announcing* -see par. 0009, par. 0038, par. 0040 lines 7-14, figs. 1 and 5: Chen discusses wherein a group call server triggers target users for establishing group communication by sending an announcement); and in response to the receiving, bringing the mobile terminal to a

state allowing reception of packets from a packet data network belonging to the mobile communication system, to enable participation in the packet-based service session of the communication group, wherein the receiving comprises receiving the triggering message so that the triggering message is receivable from the mobile communication system regardless of whether even when the mobile terminal is read to participate in the packet based service session (see pars. 0038-0040, par. 0045: Chen discusses wherein the group call request may be transmitted regardless of whether the caller's MS, as well as the target group mobile stations, has a dedicated traffic channel or not, e.g., the mobile station is in a dormant mode, and wherein the group call server also determines if the target group of mobile stations selected to participate in the group call is already running in the system).

Claims 33, 42, 57, 60, 63, and 64 address the same subject matter as claim 1, with the following observations:

The expression "unknown attachment status relative to a packet data network," in line 5 of claim 42, lines 4-5 of claim 60, and lines 6-7 of claim 64, is interpreted by the examiner as the expression "regardless of whether the mobile terminal is ready to participate in the packet-based service session" in lines 11-13 of claim 1, which reads on "dormant mode," e.g., "no active dedicated traffic channel," as discussed by Chen (see par. 0045). Therefore same rejection applies.

Consider claim 27 as amended. Chen teaches claim 26 and further discloses establishing a connection to the packet data network packet data connection (see par. 0026, par. 0040 lines 7-14).

Consider claims 28, 29, 35, and 36 as amended. Chen teaches claims 26, 27, 33, and 34 respectively and further discloses mobile station registration (see the title, the abstract, par. 0001, 0024, 0026, and 0028).

Consider claim 34 as amended. Chen teaches claim 33 and further discloses establishing connection for data transmission with a previously disconnected mobile terminal with respect to the packet data network (*disconnected* reads on *dormant* –see pars. 0038-0040).

Consider claims 40 and 56 as amended. Chen teaches claims 33 and 42 and further discloses bringing a first mobile station –caller’s MS- and a second –target MS- to another state (see pars. 0038-0040: Chen discusses wherein the group call server brings the mobile stations to the state of a condition to engage in packet communication).

Consider claims 59 and 62 as amended. Chen teaches claims 42 and 60 and further discloses sending multimedia messages (*multimedia* read on *data, voice, image, text, video, etc.* -see par. 0067).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 30, 31, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 20040203770 A1), hereafter "Chen," in view of Zabawskyj (US 20050136952 A1), hereafter "Zabawskyj."

Consider claims 30, 31, 37, and 38 as amended. Chen teaches claims 28, 29, 35, and 36 respectively, but does not disclose push-to-talk over cellular.

Zabawskyj, in related art, discloses push-to-talk over cellular (see par. 0023).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the invention of Chen with the teachings of Zabawskyj and have it include push-to-talk over cellular, thereby providing means for group communication in a wide area wireless network.

10. Claims 39, 53, 58, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 20040203770 A1), hereafter "Chen," in view of Maggenti (US Pat 6477150), hereafter "Maggenti."

Consider claims 39, 53, 58, and 61 as amended. Chen teaches claims 26, 33, and 42, but does not disclose timing a session.

Maggenti, in related art, disclose timing a session (see col. 27 lines 56-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Chen and have it include session timing, as taught by Maggenti, thereby monitoring the duration a data session.

11. Claims 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 20040203770 A1), hereafter "Chen," in view of Desai et al. (US 7277697 B2), hereafter "Desai."

Consider claims 54 and 55 as amended. Chen teaches claims 26 and 33, but does not disclose prompting a user for accepting a session invitation.

Desai, in related art, discloses prompting a user for accepting a session invitation (see col. 5 lines 27-32).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Chen and have it include prompting a user for accepting a session invitation, as taught by Desai, thereby providing means for the purpose of establishing a communication with a group inviting participants in non-intrusive manner, as discussed by Desai (see col. 2 lines 14-16).

Response to Arguments

Applicant's arguments with respect to claims 26-31, 33-40, 42, and 53-64 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Delaney Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amancio Gonzalez, whose telephone number is (571) 270-1106. The Examiner can normally be reached on Monday-Thursday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Appiah, can be reached at (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Art Unit: 2617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

AG/ag

October 29, 2008

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617